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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

FUSN1-01307US0

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Application Number

09/665,315

Filed

2000-09-19

First Named Inventor

Herbert D. Jellinek

Art Unit

2145

Examiner

Mirza, Adnan M.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/David E. Cromer/

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

David E. Cromer

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2007-01-16

Date

Registration number if acting under 37 CFR 1.34 _____

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application)	<u>PATENT APPLICATION</u>
)	
Inventors: Jellinek, et al.)	
)	Art Unit: 2145
Application No.: 09/665,315)	
)	Examiner: Mirza, Adnan M.
Filed: September 19, 2000)	
)	Customer No. 28554
Title: PERFORMING SERVER ACTIONS)	
USING TEMPLATE WITH FIELD)	
THAT CAN BE COMPLETED)	
WITHOUT OBTAINING)	
INFORMATION FROM A USER)	
_____)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants respectfully request consideration of the following remarks and arguments in connection with the Pre-Appeal Brief Request for Review submitted herewith.

REMARKS

Prior to filing an appeal brief, Applicants respectfully request that a panel of examiners formally review the legal and factual basis of the rejections in their application in accordance with the Pre-Appeal Brief Conference Pilot Program announced in the *Official Gazette*, 12 July 2005. This request is being filed simultaneously with a Notice of Appeal.

Applicants assert that the rejections of record are clearly not proper and are without basis. Legal and factual deficiencies exist in the rejections, as set forth hereinafter.

I. Summary of Rejections

Claims 1-19 and 24-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. App. Pub. No. 2003/0084121 (“*DeBoor*”), U.S. Patent No. 6,553,410 (“*Kikinis*”) and U.S. Patent No. 6,589,290 (“*Maxwell*”).

II. Failure to Consider all Claim Limitations - Claims 19 and 24-30

Applicants assert that the Examiner has omitted essential elements required to establish a prima facie case of obviousness under §103(a) by failing to consider each limitation in claims 19 and 24-30.

A. Claim 19

Applicants amended claim 19 in *Applicant’s Response C to Office Action Under 37 CFR §1.111*, filed July 27, 2005. In the next Office Action, the Examiner erroneously asserted that claim 19 “has the same limitation as to claim 1 therefore under the same circumstances claim 19 can be rejected.” See *Office Action mailed 10/18/2005*, p. 8, ¶ 20. This is incorrect. Independent claim 19 includes distinct limitations from those of claim 1. After the amendment, Claim 19 recites that “each of said templates includes a plurality of fields previously indicated to be editable or non-editable by a user defining said template,” as well as “providing at least one edit page from said server machine to said client machine for each field indicated to be editable by said user defining said template.” These limitations are not found in claim 1.

Applicants directed the Examiner to the failure to consider the added limitations in their reply, *Applicant’s Response D to Office Action under 37 CFR §1.111*, filed April 18, 2006. See pp. 14-16. Applicants noted that the limitations added by amendment on July 27, 2005 were not considered. In the next Office Action, the Examiner again erroneously asserted that claim 19 “has the same limitation as to claim 1 therefore under the same circumstances claim 19 can be rejected.” See *Office Action mailed 7/13/2006*, p. 8, ¶ 20. To date, the Examiner has not considered the added limitations.

Because each limitation of claim 19 has not been considered and given weight in determining patentability, no prima facie case of obviousness has been made. There being essential elements missing for a prima facie rejection under 103(a), Applicants respectfully request that claim 19 be allowed.

B. Claims 24-27

Applicants amended claim 24 in *Applicant’s Response C to Office Action Under 37 CFR §1.111*, filed July 27, 2005. After the amendment, claim 24 recites “said template is at least one of a message generation template, an appointment scheduling template, and a database query submission template.” In

the next Office Action, the Examiner set out the rejection of claim 24 but omitted this added limitation. *See Office Action mailed 10/18/2005, p. 8-9, ¶ 21.* Applicants directed the Examiner to the failure to consider the added limitation in their reply. *Applicant's Response D to Office Action under 37 CFR §1.111, filed April 18, 2006. See pp. 16-17.* Applicants noted that the limitations added on July 27, 2005 were not considered. In the next Office Action, the Examiner again omitted the added limitation and did not address Applicants' previous assertion that the limitation was not considered. *See Office Action mailed 7/13/2006, p. 8-9, ¶ 21.*

By not addressing each limitation of claim 24, the Examiner has not met the requirement of showing a teaching or suggestion of each claim limitation in order to present a prima facie case of obviousness under § 103(a). Because no prima facie case of obviousness has been made, Applicants respectfully request that claim 24 be allowed. Claims 25-27 each ultimately depend from claim 24. A notice of allowance as to these claims is requested for the same reasons.

C. Claims 28-30

Claims 28-30 were added in *Applicant's Response C to Office Action Under 37 CFR §1.111, filed July 27, 2005*. In paragraph 3 on pages 2-5 of the *Office Action mailed 10/18/2005*, the Examiner grouped claim 28 with the rejection of claim 1. This grouping is improper. Claim 28 includes distinct limitations from claim 1. Consequently, the grouped rejection did not address each limitation in claim 28. For instance, claim 28 recites, "said first user input indicates whether each of said first plurality of fields is an editable field or a non-editable field," "said first server action requires user input for a second plurality of fields corresponding to said first plurality of fields of said template," and "said at least one edit page is provided for less than all of said second plurality of fields requiring user input for said first server action." These claim limitations are not present in claim 1.

Accordingly, these limitations of claim 28 were not considered and given weight in determining patentability under §103(a). There being essential elements for a prima facie rejection under 103(a) missing, Applicants respectfully request that claim 28 be allowed. Claims 29-30 each ultimately depend from claim 28. Applicants request a notice of allowance as to these claims for the same reasons as claim 28.

III. Clear Error in the Rejection of Claims 1-18

Applicants assert that there are clear errors in the rejection of claims 1-18. Specifically, the limitation "performing the server action *without obtaining information from the client machine includes*,

for the at least one field, *using the previously entered user data to complete the at least one field*,” as recited in claim 1 (*emphasis added*) is not met by the prior art of record as asserted in the rejections. In fact, the reference relied upon specifically teaches away from the claimed limitation such that proper motivation for initially combining the references has not been shown.

The Examiner relies upon *Maxwell*, after noting that the combination of *DeBoor* and *Kikinis* fails to disclose the above limitation. See *Office Action*, page 4. *Maxwell*, however, discloses an application that “executes on a web client ... capable of obtaining forms from the Internet” and is “configured to allow a user to populate a form with data.” *Maxwell*, col. 9, ll. 29-35 (*emphasis added*). This client based program cannot be understood to disclose any manner of performing server actions “without obtaining information from the client machine to complete the field,” as recited in claim 1. The form in *Maxwell* is obtained from a web server by a client and a “form completion program” runs at this client to fill out the obtained form. *Id.* The form is not completed at or by the web server.

The rejections give weight to *Maxwell*’s disclosure that it is “possible to obtain data from other sources” to populate the form at the client. *Id.* at col. 11, ll. 38-44. Whether the data utilized to populate the form in *Maxwell* is stored locally or remotely is immaterial. In either case, the data is obtained by the client to fill out the form that the client has also obtained. Accordingly, nothing teaches or suggests performing a server action “without obtaining information from the client machine to complete the field.”

Further, *Maxwell* specifically teaches away from this limitation, asserting that a “problem with using CGI (Common Gateway Interface) programs is that since they are located on the server, information cannot easily be saved on the web client for later use,” and that “existing mechanisms for processing forms reside on the server and are unable to populate a form on the client with user data from users that have never visited the web site having the form.” *Id.* at col. 6, ll. 3-10. The clear indication from *Maxwell* is that server side solutions have associated problems and that its client based approach is preferable.

Claim 1, however, recites that “performing the server action without obtaining information from the client machine includes, for the at least one field, using the previously entered user data to complete the at least one field.” *Maxwell* teaches away from this concept by teaching that server based solutions are inferior and that a client based technique as disclosed is a better solution.

Accordingly, proper motivation for combining the prior art of record has not been shown, as *Maxwell* specifically teaches away from the claimed combination. Moreover, even if combined as

proposed by the Examiner, *Maxwell* does not meet the claim limitation for which it is asserted. Because clear error exists in the rejection of claim 1 as set forth above, Applicants respectfully request that claim 1 be allowed in response to this request. Claims 2-18 each ultimately depend from claim 1. Applicants request a notice of allowance as to these claims for the same reasons as claim 1.

A more detailed version of the argument presented above can be found in *Applicant's Response D to Office Action under 37 CFR §1.111, filed April 18, 2006, pp. 11-14.*

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: January 16, 2007

By: /David E. Cromer/
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